



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,532	06/25/2001	Thomas D. Doerr	951130.90011	9784
26710	7590	10/05/2006	EXAMINER RINES, ROBERT D	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497			ART UNIT 3626	
PAPER NUMBER				

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,532

Applicant(s)

DOERR ET AL.

Examiner

Robert D. Rines

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

[1] This communication is in response to the amendment filed 22 May 2006. Claims 3, 8-9, 17, and 21 have been amended. Claims 1-21 are pending.

Drawings

[2] Examiner's previous objection to the drawings set forth in the Office Action mailed 18 January 2006 are hereby withdrawn.

Claim Objections

[3] Examiner's previous objection to claims 9 and 21 set forth in the Office Action mailed 18 January 2006 are hereby withdrawn.

Claim Rejections - 35 USC § 112

[4] Examiner's previous rejection of claim 3 set forth in the Office Action mailed 18 January 2006 are hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

[5] Claims 1, 7, 10-12, 15, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans (United States Patent #5,924,074).

[A] As per independent claim 1, Evans teaches a patient-side decision support system comprising: a hand-held terminal usable during an examination and providing a display and user input device (Evans; Abstract, col. 2, lines 47-50 and col. 13, lines 13-22); a terminal server communicating with the hand-held terminal and holding medical information related to medical diagnoses as linked to a set of diagnosis codes (Evans; col. 11, lines 10-22, col. 12, lines 66-67, and col. 13, lines 1-4), the terminal server further executing a stored program to: (a) accept from the user input device of the hand-held terminal, input designating a methodology producing a subset of diagnoses codes (Evans; col. 11, lines 40-52); (b) present on the display of the hand-held terminal a navigation menu a representation of the subset of the diagnosis codes generated using the selected methodology (Evans; col. 6, lines 40-55 and col. 11, lines 30-40); (c) accept from the user input device of the hand-held terminal a selection of a particular diagnosis codes from the subset (Evans; col. 11, lines 46-50); and whereby a comprehensive set of diagnosis

codes can be present to the physician on a hand-held device at the time and location of patient examination (Evans; col. 14, lines 62-65).

[B] As per dependent claim 7, Evans teaches the methodology provides a hierarchy having at least one level of diagnosis code groupings holding a predetermined set of related diagnosis codes that may be selected by the user to reveal the subset of diagnosis codes (Evans; col. 11, lines 40-46).

[C] As per dependent claim 10, Evans teaches wherein the diagnosis codes are ICD-9 codes (Evans; col. 9, lines 4-7).

[D] As per dependent claim 11, Evans teaches wherein the terminal server further includes a table selecting only a subset of the ICD-9 codes to include in the set of diagnosis codes selectable by the user (Evans; col. 9, lines 4-7).

[E] As per dependent claim 12, Evans teaches wherein the terminal server further executes a stored program to: (d) provide to the user the medical information linked to the selected diagnosis codes (Evans; col. 11, lines 17-22).

[F] As per dependent claim 15, Evans teaches wherein the medical information is selected from the group consisting of relevant treatment options, patient handouts, and physician education information (Evans; col. 11, lines 15-22).

[G] As per (currently amended) claim 17, Evans teaches a system wherein the display provides a resolution of at least 600 X 200 pixels (Evans; col. 12, lines 57-63, and col; 13, lines 14-22).

NOTE: Evans teaches the use of multiple portable computers as candidates for the physician's point-of-care device. Examiner interprets the teachings of Evans to include a user choice of devices and, accordingly, a desired display resolution. Further, Examiner directs Applicant's attention to previous rejection of original claim 21 set forth in the 18 January 2006 Office Action, herein incorporated by reference, and in which the Examiner clearly indicates a resolution of the exemplary device taught by Evans to include resolution in excess of Applicant's 600 X 200 pixels.

[H] As per dependent claim 18, Evans teaches wherein the hand-held terminal provides a wireless link communicating with the terminal server (Evans; Abstract and col. 13, lines 15-22).

[I] As per dependent claim 19, Evans teaches wherein the physician input device is selected from a keyboard and stylus entry device (Evans; Abstract and col. 6, lines 60-65, col. 7, lines 11-14).

Art Unit: 3626

[J] As per dependent claim 20, Evans teaches wherein the display is a graphic display providing for the display of text and images (Evans; col. 5, lines 55-60 and col. 6, lines 60-65, and col. 7, lines 11-14).

[K] As per (currently amended) claim 21, Evans teaches a system wherein the terminal server and the hand-held terminal provide interfaces connecting to the Internet and wherein the terminal server connects with the hand-held terminal via the Internet (Evans; col. 12, lines 55-67 and col. 13, lines 1-29)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 2-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans in view of Abbo (United States Patent Application Publication #2003/0195774).

[A] Regarding claims 2-6, and 8 Evans does not teach the retrieval of the most frequently used diagnostic codes for a predetermined set of physicians (claims 2 and 8) or for a predetermined set of physicians practicing a common specialty (currently amended claim 3).

Art Unit: 3626

Further, Evans does not teach identifying the user and providing the most commonly used diagnosis codes for the user (claims 4 and 8) or providing the most recent diagnostic codes for the patient (claims 5 and 8). Lastly, Evans does not teach providing diagnostic codes previously selected for the user that have not been removed by editing (claim 6).

[B] As per dependent claim 2, Abbo teaches wherein the methodology provides the most frequently used diagnosis codes for a predetermined set of physicians as the subset of diagnosis codes (Abbo; paragraph [0058]).

[C] As per (currently amended) claim 3, Abbo teaches wherein the predetermined set of physicians is physicians practicing a common specialty (Abbo; paragraph [0058]).

[D] As per dependent claim 4, Abbo teaches wherein the terminal server further executes the stored program to accept from the user input device of the hand-held terminal, input identifying the user, and wherein the methodology provides the most frequently used diagnosis codes for the user (Abbo; paragraph [0058]).

[E] As per dependent claim 5, Abbo teaches wherein the terminal server further executes the stored program to accept from the user input device of the hand-held terminal, input identifying a patient, and wherein the methodology provides most recent diagnosis codes for the patient (Abbo; paragraph [0057]).

Art Unit: 3626

[F] As per dependent claim 6, Abbo teaches wherein the terminal server further executes the stored program to accept from the user input device of the hand-held terminal, input identifying a patient, and wherein the methodology provides diagnosis codes previously selected for the user that have not been removed by editing (Abbo; paragraphs [0058]).

[G] As per (currently amended) claim 8, Abbo teaches wherein the terminal server further executes a stored program to provide the user with the ability to search for a specific diagnosis code by name of the diagnosis code (Abbo; paragraphs [0057], [0058]).

[H] Regarding claim 2-6, and 8 it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Evans and Abbo. The motivation to combine would have been to provide the physician with the option of selecting a diagnosis from a list of common diagnoses used in the particular physician's office, or diagnoses commonly used in the physician's practice which are associated with a specified organ or system as part of a specialized practice (Abbo; paragraph [0058]). Further motivation would have been to provide a comprehensive, integrated computer program application and system to manage aspects of a medical practice (Abbo; paragraph [0005]).

[I] As per (currently amended) claim 9, Evans does not teach searching for a specific diagnostic code by name.

Art Unit: 3626

[J] However, Abbo does teaches a system wherein the terminal server further executes a stored program to provide the user with the ability to search for a specific diagnosis code by name of the diagnosis code (Abbo; paragraphs [0042], [0057] [0058]).

[K] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Evans and Abbo. The motivation would have been to allow the physician to enter keywords to search an entire standard list of approximately 15,000 ICD-9 diagnosis codes (Abbo; paragraph [0042]).

[7] Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Abbo as applied to claim 2 above, and further in view of Rappaport (United States Patent Application Publication #2002/0007285).

[A] As per dependent claim 16, Evans does not teach that the displayed subset is hyperlinked to a description of the diagnosis code. Abbo does teach displayed diagnosis codes are hyperlinked to select or obtain additional information about the code (Abbo; paragraph [0058]). Further, although Abbo does teach the selection of a layman's description to be associated with each diagnosis (Abbo; paragraph [0061]), Abbo does not specifically state that the description is accessible via the hyperlink.

[B] However, Rappaport teaches that for each code the database is configured to store a code description (Rappaport; paragraphs [0070] and [0071]. NOTE: Rappaport stores one or more code definitions, a code concept and other information associated with each code).

[C] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Evans and Abbo with the teachings of Rappaport. Such combination would have allowed the user to select a diagnosis code from the list by clicking on it (Abbo; paragraph [0058]) thereby accessing stored code definitions, code concept, and other information about the code (Rappaport; paragraphs [0070] and [0071]). The motivation to combine would have been to allow the healthcare provider to access, at the point of care, diagnosis information including diagnosis codes and remarks, support information and procedure/test information that are relevant to a particular diagnosis and corresponding procedure or test (Rappaport; paragraph [0025]).

[8] Claims 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Abbo as applied to claim 2 above, and further in view of Mayaud (United States Patent #5,845,255).

[A] Regarding claims 13 and 14, Evans does not teach providing to the user a set of prewritten prescriptions prepared by a team of specialists (claim 13), nor does he teach providing a set of prewritten prescriptions being the most frequently used prescriptions by the user for the selected diagnosis code (claim 14). Although Abbo teaches the selection of diagnosis by simply

Art Unit: 3626

clicking on it and Abbo further teaches that for each diagnosis entered, selecting a recommended treatment (Abbo; paragraphs [0056] and [0058]), Abbo does not teach that the selection of treatment includes selection of prewritten prescriptions that are prepared by a team of specialists (claim 13) or that the prescriptions are the most frequently prescribed for the user for the selected diagnosis code (claim 14).

[B] As per dependent claim 13, Mayaud does teach wherein the terminal server further executes a stored program to provide to the user a set of prewritten prescriptions prepared by a team of specialists (Mayaud; col. 12, lines 35-41 and col. 13, lines 13-18).

[C] As per dependent claim 14, Mayaud teaches wherein the terminal server further executes the stored program to accept from the user input device of the hand-held terminal, input identifying the user, and wherein the methodology provides a set of prewritten prescriptions being the most frequently used prescription by the user (Mayaud; col. 12, lines 49-56).

[D] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Evans and Abbo with the teachings of Mayaud. Such combination would have allowed the healthcare provider to select a diagnosis and further to select a recommended treatment for the diagnosis (Abbo; paragraph [0056]). Selected treatment would have included prewritten prescriptions most commonly used for a given specialty or most commonly used for a given diagnosis (Mayaud; col. 12, lines 49-56 and col. 13, lines 13-19). The motivation would have been to provide a prescription management system, which

Art Unit: 3626

personalizes itself to the prescribing patterns of experienced professionals (Mayaud; col. 4, lines 10-19).

Response to Remarks

Applicant's remarks filed 22 May 2006 have been fully considered but they are not persuasive.

The arguments will be addressed below in the order in which they appear in the response filed 22 May 2006.

Applicant remarks that Evans does not "teach or suggest inputting a methodology to produce a subset of diagnoses codes or presenting a navigation menu of the diagnosis codes generated using a selected methodology".

In response Examiner directs the Applicant's attention to the teachings of Evans, which state "to enter a diagnosis, a physician clicks on the scroll down button adjacent to the system box to produce a list of body systems. The physician selects the appropriate system and the diagnosis module enters the selected system in the system box and provides a list having specific diagnosis codes for the selected body system in the diagnosis box" (Evans; col. 11, lines 40-50). Examiner interprets Evans' "selection of a body system" as equivalent to Applicant's "selecting a methodology". Additionally, Examiner interprets Evans' teachings of the "diagnosis module" providing a list of relevant diagnosis codes for the specific body system as equating to

Applicant's displaying a navigation menu with representations of diagnosis codes generated using the methodology. In summary, Examiner interprets the teachings of Evans as selecting a methodology (e.g. body system) producing a subset of diagnosis codes (i.e., diagnosis codes associated with the body system).

Although Examiner understands Applicant's intention to distinguish the present application from the applied references, the Examiner respectfully submits that the present application, as currently claimed, fails to successfully and patentably distinguish itself from the applied references. Accordingly, Examiner's rejections, as presented in the Office Action mailed 18 January 2006, and reiterated in the present Office Action, are upheld.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RDR

R. D. Rines 8/4/06

Joseph Thomas
JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER